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**AUG 27 2007**

**OFFICE OF PETITIONS**

In re Application of	:	
Culpepper, et al.	:	
Application No. 09/839,616	:	DECISION
Filing Date: 20 April, 2001	:	
Attorney Docket No.: D-3032	:	

This is a decision on the petition filed on 25 August, 2006, alleging unintentional delay under 37 C.F.R. §1.137(b).

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.<sup>1</sup>

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

**BACKGROUND**

The record reflects that:

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<sup>1</sup> **NOTE:** Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected. Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.

- Petitioner failed to reply timely and properly to the final Office action mailed on 19 April, 2002 (the full paper file is not available at this writing and the Image File Wrapper (IFW), does not contain all of the substantive papers in this regard, and so the PALM record is relied upon for this history), with reply due absent extension of time on or before 19 July, 2002;
- the instant application went abandoned after midnight 19 July, 2002;
- the Office mailed a Notice of Abandonment on 10 December, 2002;
- Petitioner filed the original petition (with fee), a reply in the form of a request for continued examination (RCE) and fee and an amendment as the submission under 37 C.F.R. §1.114, and made the statement of unintentional delay—however, in light of:

the period of abandonment; the allegation that the attorney responsible was no longer available; the listing, at the time of abandonment, of registered practitioners authorized to act in the matter; and that the original Petitioner was not of record at the time of abandonment;

the Office required additional information—explanation and examples of which Petitioner was directed to the Commentary at MPEP §711.03( c) for guidance—and the petition was dismissed on 27 June, 2006;

- the instant petition with a statement by the assistant general counsel/senior intellectual property counsel of the assignee, who also was one of the counsels of records at the time the application went abandoned, detailing the history addressed the “statement/showing” requirements under the regulation—and, as noted below, the Office looks to the statement by and duty of candor of Thomas Boshinski (Reg. No. 30,611) to the Office in making a determination herein.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

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<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup> And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>))

#### As to the Allegations of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and—where appropriate—a terminal disclaimer and fee if the application was filed before 8 June, 1995.

It appears that Petitioner has satisfied the requirements under the regulation.

### CONCLUSION

The record (including the petitions filed on 26 May and 25 August, 2006) does not necessitate a

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<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>4</sup> See: Changes to Patent Practice and Procedure, Final Rule Notice, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>5</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.


finding that the delay between midnight 19 July, 2002 (the date of abandonment), and 25 August, 2006 (the date of the filing of a grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioner/Counsel Thomas Boshinski (Reg. No. 30,611) when accepting Petitioner's representation that the delay in filing the response was unintentional.<sup>8</sup>

The petition under 37 C.F.R. §1.137(b) hereby is **granted**.

The instant application is released to Technology Center 3600 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>9</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



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<sup>8</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

<sup>9</sup> The regulations at 37 C.F.R. §1.2 provide:  
**§1.2 Business to be transacted in writing.**  
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.